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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,434	02/18/2000	Ravi Acharya	47004.000059	8248
21967 7590 04/14/2009 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER ROSEN, ELIZABETH H	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 04/14/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/506,434

Applicant(s)

ACHARYA ET AL.

Examiner

ELIZABETH ROSEN

Art Unit

3692

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15, 17, 21, 55-58, 64, 65 and 68-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15, 17, 21, 55-58, 64, 65 and 68-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/3508) | 5) <input type="checkbox"/> Notices of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the Amendment and Response filed on February 20, 2008.
2. Claims 15, 17, 21, 55-58 64, 65, and 68-76 are currently pending and have been examined.

Response to Arguments

3. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
4. Examiner would like to point out that the Supreme Court in *KSR International Co. v. Teleflex Inc.* described seven rationales to support rejections under 35 U.S.C. 103:
 - Combining prior art elements according to known methods to yield predictable results;
 - Simple substitution of one known element for another to obtain predictable results;
 - Use of known technique to improve similar devices (methods, or products) in the same way;
 - Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
 - "Obvious to try" –choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
 - Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and
 - Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference (or references when combined) need not teach or suggest all the claim limitations; however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The "mere

existence of differences between the prior art and an invention does not establish the invention's nonobviousness." see *Dann v. Johnson*, 425 U.S. 219, 230 (1976).

5. Applicant argues, with regard to Claims 15, 21, and 55, that the references do not disclose "depositing the discrete value of the conventional check...without physical receipt of the conventional check." Regarding the interpretation of this limitation, "without physical receipt of the conventional check" can have several meanings. For example, it may mean a physical check is not brought within the vicinity of the system. It may also mean that a check is brought to the system, but it is not deposited into the machine. In the latter interpretation, a physical check may be scanned by the machine even if it is not received by (or deposited into) the machine. This is the method that is described in Page. Therefore, this limitation is explicitly disclosed in Page. However, if the first interpretation of this limitation is used, Talati clearly discloses the limitation by describing the depositing of an electronic check. By combining Talati with Page, the physical check is substituted with an electronic check. The electronic check is an electronic form of data which would include a routing number and account number as well as other standard check data. In the claimed invention, if a check is deposited without the use of a physical check, the machine must be using some form of data that is received by the machine and it would be obvious that this data may be received from an electronic check.

6. Applicant argues that some of the claims are rejected using portions of Page that discuss the issuer of the check. Explanations have been added to the rejections to help clarify the citations.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 15, 17, 21, 55-58 64, 65, and 68-76** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Page**, U.S. Patent Number 6,464,134 B1 in view of **Talati** et al., U.S. Patent Number 5,903,878.

Claim 15:

Page discloses the limitations of:

- (a) logging the bank customer onto an automated banking system through a customer terminal remotely located with respect to the bank and the automated banking system (see at least Page, column 6, lines 20-38 ("The cashing terminal

14, by way of example only, may be located at a bank or check cashing agency where the bank check, prepared and issued from the issuing terminal 10, is presented for redemption in terms of being deposited or cashed."); column 8, lines 15-40; and column 9, lines 20-64);

- (b). receiving transaction data entered into the customer terminal by the bank customer the transaction data comprising routing number, account number, date written and amount of a conventional check that is made payable to the bank customer (see at least Page, column 6, lines 20-38; column 8, lines 15-40 (The cashing terminal identifies or reads account data from a check that is being presented for redemption. Payee data is also entered at the terminal.); and column 9, lines 20-64 (Check data can be entered manually or it can be done electronically (e.g., by a scanner))); and
- (d). receiving by the bank customer a result of the transaction for the conventional check (see at least Page, column 9, line 20 through column 10, line 22 (If the transaction is successful, a verification signal is sent to the cashing terminal and displayed.)).

Page does not explicitly disclose, but **Talati**, however, does disclose:

- (c). depositing the discrete value of the conventional check by the automated banking system into a bank account represented by the routing number and account number without physical receipt of the conventional check by the automated banking system (see at least Talati, column 7, line 25 through column 8, line 16 (An electronic check is deposited.)).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to modify Page with the teachings of Talati because such a modification would allow Page to have an electronic check to be initiated as a payment transaction to the payee with a discrete value (amount) where the payee requests payment of the electronic check or deposits the electronic check into the payee bank. In Talati, there is no receipt of a physical check.

Claim 17:

Page further discloses:

- The value of the check is deposited into the payee's account (see at least Page, column 6, lines 30-31).

Page does not explicitly disclose:

- wherein the result of the transaction in step (d). comprises a provisional credit to the bank customer payee's account.

However, Examiner takes **Official Notice** that this is old and well known in the art of banking transactions. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate in Page a provisional credit to the bank customer payee's account in view of Page's discussion of where the bank check prepared and issued from the issuing terminal is presented for redemption in terms of being deposited or cashed (see Page, column 6, line 27 through column 7, line 23). In the art of banking and accounting, when the check is deposited into the payee's account, the bank account is credited. This is simply well known accounting procedures of credits and debits. The practice of crediting a bank account is to prevent the bank account from being closed or withdrawal of funds from being overdrawn when making payments to creditors.

Claim 21:

Page discloses the limitations of:

- (a.) receiving a request from the bank customer who enters the request through a terminal remotely located from the bank for authorization to make a transaction using an automated banking system, wherein the terminal is remotely situated from the automated banking system (see at least Page, column 6, lines 20-38 ("The cashing terminal 14, by way of example only, may be located at a bank or check cashing agency where the bank check, prepared and issued from the issuing terminal 10, is presented for redemption in terms of being deposited or cashed."); column 8, lines 15-40; and column 9, lines 20-64);
- (b.) authorizing the bank customer as a user on the automated banking system (see at least Page, column 6, lines 20-38; column 8, lines 15-40; and column 9, lines 20-64); and
- (c.) receiving transaction data entered into the terminal by the bank customer, wherein the transaction data is related to the deposit of a conventional check that is made payable to the bank customer, where the payor of the conventional check is someone other than the bank customer (see at least Page, column 6, lines 20-38; column 8, lines 15-40 (The cashing terminal identifies or reads account data from a check that is being presented for redemption. Payee data is also entered at the terminal.); and column 9, lines 20-64 (Check data can be entered manually or it can be done electronically (e.g., by a scanner))).

Page does not explicitly disclose, but Talati, however, does disclose:

- (d.) depositing the discrete value of the check without physical receipt of the conventional check by the automated banking system (see at least Talati, column 7, line 25 through column 8, line 16 (An electronic check is deposited.)).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to modify Page with the teachings of Talati because such a modification would allow Page to have an electronic check to be initiated as a payment transaction to the payee with a discrete value (amount) where the payee requests payment of the electronic check or deposits the electronic check into the payee bank. In Talati, there is no receipt of a physical check.

Claim 55:

Page discloses the limitations of:

- (a.) receiving conventional checks payable to the bank customer (see at least Page, column 6, lines 20-38 ("The cashing terminal 14, by way of example only, may be located at a bank or check cashing agency where the bank check, prepared and issued from the issuing terminal 10, is presented for redemption in terms of being deposited or cashed."); column 8, lines 15-40, 56-58; and column 9, lines 20-64);
- (b.) logging the bank customer onto an automated banking system from a customer terminal that was previously associated with a demand deposit account of the bank customer, wherein the customer terminal is remotely located from the automated banking system, wherein further access to the customer terminal is controlled by the bank customer (see at least Page, column 6, lines 20-38 ("The cashing terminal 14, by way of example only, may be located at a bank or check cashing agency where the bank check, prepared and issued from the issuing terminal 10, is presented for redemption in terms of being deposited or cashed."); column 8, lines 15-40; and column 9, lines 20-64);
- (c.) receiving transaction data entered into the customer terminal by the bank customer, the transaction data comprising routing number, account number, date written and amount of each conventional check (see at least Page, column 6, lines 20-38; column 8, lines 15-40 (The cashing terminal identifies or reads account data from a check that is being presented for redemption. Payee data is also entered at the terminal.); and column 9, lines 20-64 (Check data can be entered manually or it can be done electronically (e.g., by a scanner))); and

- (e.) receiving a result of the transaction for each conventional check (see at least Page, column 9, line 20 through column 10, line 22 (If the transaction is successful, a verification signal is sent to the cashing terminal and displayed.)).

Page does not explicitly disclose, but **Talati**, however, does disclose:

- (d.) depositing the discrete value of each conventional check by the automated banking system into the associated demand deposit account without physical receipt of each conventional check by the automated banking system (see at least Talati, column 7, line 25 through column 8, line 16 (An electronic check is deposited.)).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to modify Page with the teachings of Talati because such a modification would allow Page to have an electronic check to be initiated as a payment transaction to the payee with a discrete value (amount) where the payee requests payment of the electronic check or deposits the electronic check into the payee bank. In Talati, there is no receipt of a physical check.

Claim 56:

Page further discloses:

- wherein the customer terminal comprises a digital image scanner comprising optical recognition software capable of converting machine printed characters to electronic text (see at least Page, column 8, lines 18-29 (The cashing terminal includes scanner such as an optical scanner.)).

Claim 57:

Page further discloses:

- wherein entering transaction data into the customer terminal comprises scanning the checks using the digital image scanner (see at least Page, column 8, lines 15-40 (see at least Page, column 8, lines 18-29 (The cashing terminal includes scanner such as an optical scanner.)).

Claim 58:

Page further discloses:

- The value of the check is deposited into the payee's account (see at least Page, column 6, lines 30-31).

Page does not explicitly disclose:

- wherein the result of the transaction in (e.) comprises a provisional credit to the associated demand deposit account.

However, Examiner takes **Official Notice** that this is old and well known in the art of banking transactions. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate in Page a provisional credit to the bank customer payee's account in view of Page's discussion of where the bank check prepared and issued from the issuing terminal is presented for redemption in terms of being deposited or cashed (see Page, column 6, line 27 through column 7, line 23). In the art of banking and accounting, when the check is deposited into the payee's account, the bank account is credited. This is simply well known accounting procedures of credits and debits. The practice of crediting a bank account is to prevent the bank account from being closed or withdrawal of funds from being overdrawn when making payments to creditors.

Claim 64:

Page further discloses:

- (f.) optionally subjecting each conventional check to one or more actions to prevent redeposit of the conventional check (see at least Page, column 9, line 20 through column 10, line 22 (It is determined whether a check has been presented for redemption.)).

Claim 65:

Page further discloses:

- wherein the one or more actions comprise marking each conventional check by human or machine readable ink, physical capture of each conventional check or combinations thereof (see at least Page, column 9, line 20 through column 10, line 22 (It is determined whether a check has been presented for redemption based on data that is read from a check.)).

Claim 68:

Page further discloses:

- wherein entering transaction data into the customer terminal comprises entering transaction data via a magnetic ink character reader or a digital image scanner (see at least Page, column 9, lines 20-64).

Claim 69:

Page further discloses:

- wherein the digital image scanner comprises optical recognition software to convert machine printed characters to electronic text (see at least Page, column 8, lines 18-29 (The cashing terminal includes scanner such as an optical scanner.) and column 9, lines 20-64).

Claim 70:

Page further discloses:

- wherein the digital image scanner comprises intelligent character recognition software to convert handwritten characters to electronic text (see at least Page, column 8, lines 18-29 (The cashing terminal includes scanner such as an optical scanner.) and column 9, lines 20-64).

Claim 71:

Page further discloses:

- wherein entering transaction data into the terminal comprises entering transaction data via a magnetic ink character reader or a digital image scanner (see at least Page, column 8, lines 18-29 (The cashing terminal includes scanner such as an optical scanner.) and column 9, lines 20-64).

Claim 72:

Page further discloses:

- wherein the digital image scanner comprises optical recognition software to convert machine printed characters to electronic text (see at least Page, column 8, lines 18-29 (The cashing terminal includes scanner such as an optical scanner.) and column 9, lines 20-64).

Claim 73:

Page further discloses:

- wherein the digital image scanner comprises intelligent character recognition software to convert handwritten characters to electronic text (see at least Page, column 8, lines 18-29 (The cashing terminal includes scanner such as an optical scanner.) and column 9, lines 20-64).

Claim 74:

Page further discloses:

- wherein entering transaction data into the customer terminal comprises entering transaction data via a magnetic ink character reader or a digital image scanner (see at least Page, column 8, lines 18-29 (The cashing terminal includes scanner such as an optical scanner.) and column 9, lines 20-64).

Claim 75:

Page further discloses:

- wherein the digital image scanner comprises optical recognition software to convert machine printed characters to electronic text (see at least Page, column 8, lines 18-29 (The cashing terminal includes scanner such as an optical scanner.) and column 9, lines 20-64).

Claim 76:

Page further discloses:

- wherein the digital image scanner comprises intelligent character recognition software to convert handwritten characters to electronic text (see at least Page, column 8, lines 18-29 (The cashing terminal includes scanner such as an optical scanner.) and column 9, lines 20-64).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Rosen whose telephone number is 571-270-1850. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm, ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth H. Rosen/
Patent Examiner, Art Unit 3692

/Kambiz Abdi/
Supervisory Patent Examiner, Art Unit 3692